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09/649,946	08/29/2000	Alicia Anne Chastain	RSW9-2000-0064US1	9155

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EXAMINER

JOHNSON, MARLON B

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 04/09/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/649,946

Applicant(s)

CHASTAIN ET AL.

Examiner

Marlon Johnson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections – 35 U.S.C. 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 24,

The statement "...the routing means..." lacks an antecedent basis, as there is no mention of a routing means in claim 22, upon which claim 24 depends upon.

### ***Claim Rejections – 35 U.S.C. 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 13, 34, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Elson (6,216,122).

In considering claims 13, 34, and 39,

Elson discloses a method, a data processing system, and a computer program product for processing electronic messages, comprising the steps of:

identifying an action on an electronic message (search action) (see col. 3, lines 27-45);

identifying characteristics of the electronic message using a criteria to form a comparison (see col. 3, lines 27-45, lines 55-63); and

generating a rule to process electronic messages including the action and a selected characteristic identified in the comparison (see col. 3, lines 27-45, lines 55-63; col. 4, lines 19-28).

***Claim Rejections – 35 U.S.C. 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-12, 14-16, 22-24, and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elson.

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In considering claims 1, 22, and 38,

Elson discloses a method, data processing system, and a computer program product in a computer readable medium for creating rules to process electronic messages:

comparing characteristics of the electronic message with other electronic messages in the folder to form a comparison (see col. 3, lines 27-45); and  
generating a rule to process electronic messages based on the comparison (see col. 3, lines 27-45, lines 55-63; col. 4, lines 19-28).

Although Elson shows substantial features of the claimed invention, he fails to disclose detecting user input moving an electronic message into a folder. However, prior art, as admitted in the background of Elson, discloses such a detection of a user input moving an electronic message into a folder (see col. 2, lines 10-23; Fig. 1). Therefore, given the teachings of the prior art, it would have been obvious for a person having ordinary skills in the art to modify Elson by detecting user input moving an electronic message into a folder in order to provide both manual and automatic actions of the message.

In considering claims 2 and 23,

Elson discloses a method and system further comprising:  
processing received messages using the rule (see col. 3, lines 27-45, lines 55-63).

In considering claims 3 and 24,

Elson discloses a method and system wherein the processing step is initiated in response to another user input approving use of the rule (via either folders or objects to search) (see col. 3, lines 27-45).

In considering claim 4,

Elson discloses a method wherein the criteria includes priority-based common fields and common content (see col. 3, lines 27-45).

In considering claim 6,

Elson discloses a method wherein the comparing step, and the generating step are initiated in response to a selected user input (see col. 3, lines 27-45).

Additionally,

The prior art of Elson discloses a method wherein the detecting step is initiated in response to a selected user input (see col. 2, lines 10-23).

In considering claim 7,

Elson discloses a method wherein at least one of a sender address, a selected word in a subject line body of the electronic message, a select word in a body of the electronic message, and an attribute of the time/date field of the electronic message (see col. 3, lines 27-45).

In considering claim 8,

Elson discloses a method wherein the other electronic messages in the folder are electronic messages selected through user input (via file pointers) (see col. 3, lines 64-67 and col. 4, lines 1-14).

In considering claim 9,

Although Elson shows substantial features of the claimed invention, he fails to disclose generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are absent. Nonetheless, the use of characteristics which are based upon the absence of messages would have been an obvious modification to the system disclosed by Elson. It would have been obvious for a person having

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ordinary skills in the art to modify Elson by generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are absent in order to expand the desired user characteristics for generating the rule.

In considering claim 10,

Although Elson shows substantial features of the claimed invention, he fails to disclose generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are unselected by user input. Nonetheless, the use of characteristics which are based upon unviewed/unselected messages would have been an obvious modification to the system disclosed by Elson. It would have been obvious for a person having ordinary skills in the art to modify Elson by generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are unselected by user input in order to further expand the desired user characteristics for generating the rule.

In considering claim 11,

Elson discloses a method further comprising:

presenting the rule for review (see col. 3, lines 27-45); and

using the rule to process electronic messages if user input accepting the rule is received (see col. 3, lines 27-45) [note: in order to use the rule, it must be accepted by the user].

In considering claims 14 and 35,

Although Elson shows substantial features of the claimed invention, he fails to disclose the action being a deletion of the electronic message. Nonetheless, deleting electronic messages

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are commonly used for mail applications and would have been an obvious modification to the system disclosed by Elson. It would have been obvious for a person having ordinary skills in the art to modify Pager et al. by having the action being a deletion of the electronic message in order to provide an action for the complete removal of a message from the system.

In considering claims 15 and 36,

Elson discloses a method and data processing system further comprising:

responsive to the action being performed on other electronic messages comparing characteristics of the electronic message the other electronic messages (via pointers) (see col. 3, lines 45-54, lines 64-67, and col. 4, lines 1-14).

In considering claims 16 and 37,

The prior art of Elson discloses a method wherein the action is a movement of the electronic message into a folder containing other electronic messages and wherein the step of identifying characteristics comprises:

comparing the electronic message to other electronic messages using the criteria to form the comparison (see col. 2, lines 10-23).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson, as applied to claim 1 above, and further in view of Plank et al. (5,978,566).

In considering claim 5,

Although Elson shows substantial features of the claimed invention, he fails to disclose a method wherein the folder is a trash folder. However, Plank et al., whose invention is a server based electronic messaging system with user-definable rules with actions specified in triggered rules whose conditions are satisfied, discloses such a trash folder (see col. 1, lines 22-30; Fig. 2,



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Trash Folder 60). Therefore, given the teachings of Plank et al., it would have been obvious for a person having ordinary skills in the art to modify Elson by using a trash folder to use generated rules that are based on getting rid of unwanted messages.

8. Claims 12, 17-21, 25, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elson as applied to claim 11 above, and further in view of Millier et al. (5,899,995).

In considering claim 17,

Although Elson shows substantial features of the claimed invention, he fails to specifically disclose a data processing system comprising a bus system, a communications unit connected to the bus system, a memory connected to the bus system, and a processing unit connected to the bus system. However, Millier et al., whose invention is a method and apparatus for automatically organizing information into multiple storage elements, discloses such a data processing system comprising a bus system, a communications unit connected to the bus system, a memory connected to the bus system, and a processing unit connected to the bus system (see col. 4, lines 63-65; col. 5, lines 14-29; Fig. 1, Processor 15, Host Bus 20, Memory 30, Communication Controller 70). Therefore, given the teachings of Millier et al., it would have been obvious for a person having ordinary skills in the art to modify Elson by using a data processing system comprising a bus system, a communications unit connected to the bus system, a memory connected to the bus system, and a processing unit connected to the bus system in order to use a computing device for executing the invention.

In considering claim 18,

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Although Elson and Millier et al. show substantial features of the claimed invention, they fails to disclose the bus system being a single bus (i.e. two separate buses are used).

Nonetheless, the inclusion of the two buses into one single bus would have been an obvious modification to Elson and Millier et al., as it is well settled that a prima facie case of obvious design choice includes taking separable things and making them integral. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ, 347, 349 (CCPA 1965); see also MPEP § 2144.04. It would have been obvious for a person having ordinary skills in the art to modify Elson and Millier et al. by using a single bus in order to reduce the number of different line carrying information, thus utilizing board space more efficiently.

In considering claim 19,

Millier et al. discloses a data processing system wherein the bus system includes a primary bus and a secondary bus (see Fig. 1, Host Bus 20, Peripheral Bus 40).

In considering claim 20,

Millier et al. discloses a data processing system wherein the processing unit includes a plurality of processors (see Fig. 1, Processors 15<sub>1</sub> – 15<sub>N</sub>).

In considering claim 21,

Millier et al. discloses a data processing system wherein the communications unit is one of a modem and Ethernet adapter (see Fig. 1, Network Interface 80).

In considering claim 25,

Elson discloses a data processing system wherein the criteria includes priority-based common fields and common content (see col. 3, lines 27-45).

In considering claim 27,

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Elson discloses a data processing system wherein the comparing step, and the generating step are initiated in response to a selected user input (see col. 3, lines 27-45).

Additionally,

The prior art of Elson discloses a method wherein the detecting step is initiated in response to a selected user input (see col. 2, lines 10-23).

In considering claim 28,

Elson discloses a data processing system wherein at least one of a sender address, a selected word in a subject line body of the electronic message, a select word in a body of the electronic message, and an attribute of the time/date field of the electronic message (see col. 3, lines 27-45).

In considering claim 29,

Elson discloses a data processing system wherein the other electronic messages in the folder are electronic messages selected through user input (via file pointers) (see col. 3, lines 64-67 and col. 4, lines 1-14).

In considering claim 30,

Although Elson shows substantial features of the claimed invention, he fails to disclose generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are absent. Nonetheless, the use of characteristics which are based upon the absence of messages would have been an obvious modification to the system disclosed by Elson. It would have been obvious for a person having ordinary skills in the art to modify Elson by generating the rule to process electronic messages

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based on characteristics of the electronic message if other electronic messages in the folder are absent in order to expand the desired user characteristics for generating the rule.

In considering claim 31,

Although Elson shows substantial features of the claimed invention, he fails to disclose generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are unselected by user input. Nonetheless, the use of characteristics which are based upon unviewed/unselected messages would have been an obvious modification to the system disclosed by Elson. It would have been obvious for a person having ordinary skills in the art to modify Elson by generating the rule to process electronic messages based on characteristics of the electronic message if other electronic messages in the folder are unselected by user input in order to further expand the desired user characteristics for generating the rule.

In considering claim 32,

Elson discloses a data processing system further comprising:

presenting the rule for review (see col. 3, lines 27-45); and

using the rule to process electronic messages if user input accepting the rule is received (see col. 3, lines 27-45) [note: in order to use the rule, it must be accepted by the user].

In considering claims 12 and 33,

Millier et al. discloses a method and data processing system further comprising:

presenting a modification of the rule if user input accepting the rule is absent (see col. 10, lines 31-42; Fig. 8, Steps S820 and S825).

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9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson, as applied to claim 21 above, and further in view of Millier et al. and Plank et al.

In considering claim 26,

Plank et al. discloses a data processing system wherein the folder is a trash folder (see col. 1, lines 22-30; Fig. 2, Trash Folder 60).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (Gross et al. 5283856, Shuman 6424995, Rice et al. 6411947, Ouchi 5978836).

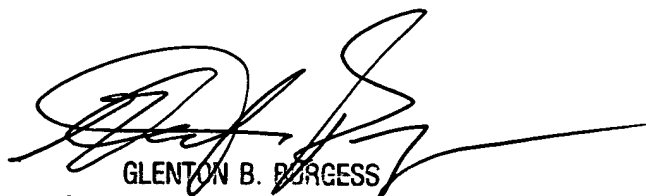
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon Johnson whose telephone number is (703) 305-4642.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Marlon B. Johnson

  
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